

THIS OPINION IS
NOT A PRECEDENT OF
THE T.T.A.B.

Oral Hearing:
February 24, 2011

Mailed:
September 29, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cavern City Tours Ltd.

v.

Hard Rock Café International, Inc.

Cancellation No. 92044795

Paul C. Rapp, Esq. for Cavern City Tours Ltd.

Joseph J. Weissman of Johnson, Pope, Bokor, Ruppel & Burns,
LLP for Hard Rock Café International, Inc.

Before Bucher, Grendel and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

On February 29, 2000, Registration No. 2324683 ("the
'683 registration") for the mark CAVERN CLUB (in typed or
standard character form, with CLUB disclaimed) issued on the
Principal Register to Hard Rock Café International, Inc.
("respondent") for "clothing, namely T-shirts, sweatshirts,
polo shirts, sport shirts, jackets, hats, caps, bolo ties,
belts, and sun visors" in International Class 25; and for

Cancellation No. 92044795

"restaurant, bar and prepared take-out food services" in International Class 42, based on an application filed on April 18, 1994. The '683 registration claims first use anywhere and first use in commerce in September 1999 for the International Class 25 goods; and first use anywhere and first use in commerce in September 1998 for the International Class 42 services. The Office renewed the registration on March 3, 2010.

Cavern City Tours Ltd. ("petitioner") petitioned to cancel the '683 registration, alleging in its amended complaint The Cavern Club is a rock and roll club opened in Liverpool, England in 1957; that petitioner and its predecessors-in-interest have used the name and mark THE CAVERN CLUB for entertainment related services and promotional merchandise since then; that between 1961 and 1963, the Beatles performed at The Cavern Club almost 300 times; and that The Cavern Club is known as the birthplace of the Beatles. Additionally, petitioner alleges that it promoted The Cavern Club extensively in the United States; that since at least 1985, it has advertised and sold tickets to The Cavern Club in the U.S. and to U.S. consumers; that most often, these tickets are part of a rock and roll travel package whose destination is Liverpool and The Cavern Club; and that in 1999, Paul McCartney, one of the original members of The Beatles, appeared at The Cavern Club in a

concert which had over five-hundred million viewers worldwide. Petitioner alleges a number of claims but only pursues two claims in its main brief. First, petitioner pleads fraud by respondent, alleging that respondent was "intimately familiar with Petitioner's mark and its fame" when it filed its application and stated under oath that it was entitled to use the mark in commerce and that no other person, firm, corporation or association had the right to use the mark in commerce; that these statements were false; that respondent knew they were false; and that they were made with an intent to deceive the Office to grant a registration to petitioner.¹ Second, petitioner pleaded a claim of false suggestion of a connection with petitioner under Section 2(a) of the Trademark Act, 15 U.S.C.

§ 1052(a), namely:

The use made by Registrant of the brand CAVERN CLUB is identical to Petitioner's world famous mark THE CAVERN CLUB for very similar services and such use is intended to falsely suggest, in violation of Section 2(a) of the Trademark Act, a connection with Petitioner when such connection is neither warranted nor authorized. Registrant's use points uniquely and unmistakably to Petitioner, and is intended to do so. Because of the fame and recognition of Petitioner and THE CAVERN CLUB mark amongst rock and roll fans for entertainment services, Registrant is obtaining by its conduct the benefit of an association to which it is not entitled.

Amended complaint ¶ 21.

¹ Petitioner abandoned its fraud claim with respect to respondent's signing and/or filing of its Section 15 declaration.

Respondent, in its answer, has denied the salient allegations of the petition to cancel. Both petitioner and respondent have filed briefs in this case. An oral hearing was held on February 24, 2011.

Evidentiary Issues

On December 11, 2009, respondent filed a motion to strike all of the documents filed as docket entry nos. 66 - 69 on TTABVUE, the Board's electronic docket. Respondent maintains they should be stricken because (i) none of the filings contained a notice of reliance cover sheet specifying the contents of the filings, (ii) the filings did not indicate a description of the proffered materials or indicate the relevance of those materials, (iii) some of the documents were articles or printouts of articles from various publications, and (iv) 37 CFR § 2.122(e) requires the relevance of these articles be stated. See TBMP §§ 704.02 and 704.08 (3d ed. rev. 2011).

Because on December 15, 2009, prior to the commencement of respondent's testimony period as reset in the Board's order dated August 31, 2009, petitioner filed descriptions of the materials submitted as docket entry nos. 66 - 69, which identify the documents submitted and their relevance, respondent's motion to strike is denied.

In addition, respondent repeated its hearsay objection first raised in Mr. Jones' testimony deposition to Mr. Jones' testimony regarding litigation in the United Kingdom involving The Cavern Club name. Respondent's objection to Mr. Jones testimony is well taken and is sustained. No further consideration is given to Mr. Jones' testimony regarding the litigation. Fed. R. Evid. 802.

Further, respondent objected on the ground of relevance to various articles that petitioner relies on in support of its claim of fame. According to petitioner, the articles discuss the old Cavern Club, not the new Cavern Club, and the Board in a prior order determined that "fame of the original Cavern Club has no relevance to these proceedings." Brief fn. 11. Respondent's objection is overruled; respondent has not specified by document or document number which articles it is objecting to and we will not venture a guess as to which articles are the subject of respondent's objection. Also, the articles are relevant to the history of The Cavern Club.

Finally, respondent's hearsay objection to Ex. C and D to Mr. Jones testimony deposition consisting of excerpts from books and to "other evidence through which Petitioner seeks to prove the fame of the original Cavern Club" is overruled. We have not considered the book excerpts and

album sleeve notes forming the exhibits for the truth of any assertion contained therein.

The Record

The record consists of the pleadings and the file of the involved registration. In addition, the parties have introduced the following evidence into the record:

- Petitioner's notices of reliance introducing (i) respondent's response to petitioner's first requests for admissions; (ii) news articles; (iii) the discovery deposition of James Humann, identified as respondent's senior director for business affairs, and exhibits thereto; and (iv) the discovery deposition of Rebecca Roby, also identified as respondent's senior director for business affairs, and exhibits thereto;

- Respondent's notices of reliance introducing (i) the affidavit of Jeffrey Koenig, an entrepreneur in California who purchased a brick from the original Cavern Club structure, with exhibits; (ii) various documents listed in the parties' January 18, 2010 stipulation;² and (iii) the discovery deposition of David Jones, one of petitioner's

² The parties stipulated on January 18, 2010 to (i) the admissibility of Mr. Koenig's affidavit with exhibits as "both authentic and fully admissible in this matter as if it were live testimony," and (ii) the authenticity and admissibility of numerous documents involving respondent and respondent's mark. The stipulation is approved, and the parties are commended for using stipulations which simplify the introduction of certain evidence into the record.

directors (hereinafter "Jones I"), under Fed. R. Civ. P. 30(b)(6), and exhibits thereto; and

• Four testimonial depositions (with accompanying exhibits), namely, those of:

- (a) Mr. Jones (hereinafter "Jones II");
- (b) Gordon Thompson, professor of music at Skidmore College, offered as a first expert witness for petitioner;
- (c) Anthony DeCurtis, a writer, offered as a second expert witness for petitioner; and
- (d) Richard Gehr, also a writer, offered as a third expert witness for petitioner.

Petitioner has not objected to the qualifications of Messrs. Thompson, DeCurtis and Gehr as experts; we likewise have considered the witnesses to be experts in their fields.

Findings of Fact

In 1957, a live-music establishment named The Cavern Club ("the original Cavern Club") opened in Liverpool, England in the cellar of a warehouse at 10 Mathew Street. Many bands played there; The Beatles played approximately 300 times at The Cavern Club, performing there from February 1961 until August 1963. Jones II at 10. The original Cavern Club went into bankruptcy at the beginning of 1966; new owners opened a club in the same location as the original Cavern Club and under the same name later in 1966. Jones II at 10.

In May 1973, British authorities forced The Cavern Club to close when British Rail seized the property by eminent domain to install a ventilation shaft for Liverpool's new underground railway system. Jones II at 11. At that time, the below-ground club was filled with rubble from the warehouse above, which was demolished. However, the shell of the club and its prominent archways were left intact. Jones II at 12.

On December 8, 1980, when John Lennon, a member of The Beatles, was murdered in New York, thousands of people gathered on the site of The Cavern Club. Jones II at 19. After John Lennon's death, tourism in Liverpool, especially Beatles-related tourism, increased, and The Cavern Club location was included on tours, as well as places which were the subject of Beatles' songs such as "Penny Lane" and "Strawberry Fields." Jones II at 20 - 22.

Royal Life Insurance gained ownership of and developed the site where The Cavern Club is located; the debris was removed from the underground structure, the original bricks were cleaned, and the space was somewhat reconfigured. On April 26, 1984, a new proprietor reopened The Cavern Club. Jones II at 25 - 27. However, it closed again in 1989, when the proprietor at the time was evicted.

In 1983, three Liverpool schoolteachers who wanted to provide more in-depth Beatles-oriented tours formed

petitioner. Jones II at 35 - 36. Mr. Jones joined petitioner in 1986. Petitioner provided daily Beatles-oriented tours of Liverpool under the designation "Magical Mystery Tours," and included The Cavern Club on its tours. Jones II at 34 - 37.

In 1991, after The Cavern Club had been closed for two years, petitioner leased The Cavern Club from Royal Life Insurance. Jones II at 75 - 83. Petitioner's lease expires in 2028. Jones II at 83. Since 1991, petitioner has been continuously offering music and live entertainment at The Cavern Club in addition to its Beatles-themed tours of Liverpool. Jones II at 38.

Petitioner's tour services, which include stops at The Cavern Club, were promoted through the British Tourist Authority which had offices in the United States, and through American tour operators (including those offering Beatles-related tours). Jones I at 43. The British Tourist Authority networked with the U.S. media and U.S. airlines to promote Liverpool as a tourist destination, particularly featuring Beatles-related tourism. Jones II at 43 - 45. Petitioner has never directly advertised The Cavern Club in the United States. Jones I at 44. Until 1999, petitioner did not own any websites on which it advertised its services. Jones I at 45.

In December 1999, Paul McCartney, a member of the Beatles, chose The Cavern Club for what was purported to be his last performance of the Twentieth Century. The event was broadcast live on the Internet, with an estimated 55 million viewers, and was rebroadcast the following day in the United States on network television. Jones II at 119 - 126. The performance is available on DVD under the title "Paul McCartney Live at The Cavern Club." Jones II at 124, Jones Ex. S. The DVD was released in 2001. Gehn ex. W.

The Rolling Stones, the Who, Queen and Elton John have performed at The Cavern Club. Gehr, Ex. W.

In April 1994, Mr. Jones granted an interview with a Toronto, Canada radio station regarding the opening of a Cavern Club in Toronto. Mr. Jones mentioned in the interview that petitioner planned to establish a Cavern Club-themed nightclub in the United States. Jones II at 97 - 99. Approximately one week later, respondent filed its application for the CAVERN CLUB mark.

Standing

Standing is a threshold issue that must be proven in every *inter partes* case. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) ("The facts regarding standing ... must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its

[pleading]."). To establish standing in a cancellation, petitioner must show both "a real interest in the proceedings as well as a 'reasonable' basis for his belief of damage." See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Petitioner has demonstrated that it operates The Cavern Club in Liverpool, England as a live music venue, and it owns registrations in various countries for THE CAVERN CLUB, the same mark as respondent's registered mark. Jones II at 38. We find that petitioner has established its standing to bring this cancellation proceeding.

Fraud

As noted earlier in this opinion, petitioner's claim of fraud stems from respondent's sworn statement in its application that no other person, firm, corporation or association had the right to use the mark in commerce, even though respondent allegedly was "intimately familiar with Petitioner's mark and its fame" when it filed its application. Specifically, respondent verified that:

... to the best of [the verifier's] knowledge and belief no other person, firm, corporation, or association has the right to use the ... mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods and services of such other person, to cause confusion, or to cause mistake, or to deceive ...

Trademark Act Section 1(a)(3)(D), 15 U.S.C. §1051(a)(3)(D).

Fraud in obtaining a trademark registration occurs "when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986); *Mister Leonard Inc. v. Jacques Leonard Couture Inc.*, 23 USPQ2d 1064, 1065 (TTAB 1992) ("Thus, according to *Torres*, to constitute fraud on the PTO, the statement must be (1) false, (2) a material representation and (3) made knowingly."). "[T]he very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). Furthermore, fraud will not lie if it can be proven that the statement, though false, was made with a reasonable and honest belief that it was true. See *Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon)*, 43 USPQ2d 1440 (TTAB 1997).

To prevail on a fraud claim that the declaration or oath in defendant's application for registration was executed fraudulently, the party claiming fraud must allege particular facts, which, if proven, would establish that:

- (1) there was in fact another user (petitioner, here) of the same or a confusingly similar mark at the time the oath was

signed; (2) the other user had legal rights superior to respondent's; (3) respondent knew that the other user had rights in the mark superior to respondent's, and either believed that a likelihood of confusion would result from respondent's use of its mark or had no reasonable basis for believing otherwise; and that (4) respondent, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled. *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768 (TTAB 2010); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203 (TTAB 1997).

The parties, in their briefs, argue at length regarding whether petitioner had rights to THE CAVERN CLUB in the United States. We need not resolve this issue because, as discussed below, petitioner has not carried its burden of establishing that (i) respondent knew of any rights petitioner had to the mark when it filed its application; and (ii) respondent intended to procure a registration to which it was not entitled. See *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1905-06 (TTAB 2006) ("in determining whether MTO procured and maintained its registration fraudulently, we need not reach the question of whether the activities relied on by MTO are sufficient to establish that it rendered cleaning services in interstate commerce. ... In other words, we need only decide whether

MTO's president, Ms. Kern, at the time of filing the application, the Section 8 declaration, and the application for renewal, knowingly made a false representation with respect to use of the mark in interstate commerce. If she had a reasonable or legitimate basis for the representations, then MTO has not committed fraud.").

In support of its argument that respondent knew of any rights petitioner had to THE CAVERN CLUB in the United States prior to the filing of its application, petitioner states:

Evidence herein includes HRC's April 1994 application for the mark Cavern Club, made apparently by outside trademark counsel ... Evidence herein discloses HRC, a huge international corporation that holds itself out as one of the world's largest repository of rock and roll memorabilia, including thousands of pieces Beatles memorabilia and dozens of pieces of Liverpool Cavern Club memorabilia, professing that it believes that no other entity has the right to use the mark Cavern Club in the United States. And this application was filed mere days after David Jones, a director of Cavern City Tours, announced on a Toronto, Canada radio station that CCT intended to expand its operations to North America.

A review of the record must lead the TTAB to the inescapable conclusion that in April 1994 HRC well knew of CCT's and its predecessor's prior use of the Cavern Club mark in the United States, in particular the near-constant usage of the mark in the United States since 1983. Given HRC's deep involvement with trademarks, HRC must be held to a high standard of awareness of trademark law and principles, such that it clear[ly] knew that CCT had superior rights to it for the use of the mark Cavern Club for bar and restaurant services related merchandise.

Brief at 32 - 33. In *Intellimedia Sports*, 43 USPQ2d at 1207, the Board stated:

... [I]f the other person's rights in the mark, vis-a-vis the applicant's rights, are not known by applicant to be superior or clearly established, e.g., by court decree or prior agreement of the parties, then the applicant has a reasonable basis for believing that no one else has the right to use the mark in commerce, and the applicant's averment of that reasonable belief in its application declaration or oath is not fraudulent.

Here, petitioner has not identified any individual connected in any way with respondent who knew of petitioner's alleged rights to the mark in the United States prior to the filing of respondent's application. Further, petitioner has presented no evidence that there has been any prior litigation between the parties or any prior decision by a court establishing that petitioner has prior rights in the mark vis-à-vis respondent. There is no evidence of any prior agreement between the parties which establishes that petitioner has superior rights in the mark. There is no evidence in the record of any other facts which would show that respondent had actual knowledge of petitioner's asserted superior rights in the mark, and which would preclude respondent from having had a reasonable basis for its claim of ownership of the mark in the application.

Moreover, Mr. Jones, one of petitioner's directors, testified as follows in petitioner's Fed. R. Civ. P. 30(b)(6) discovery deposition:

Q. Do you have any evidence that Hard Rock Café was familiar with the Cavern City's Cavern Club mark at any time prior to 2000?

A. I don't have any. Cavern City Tours is not in possession of any documentary evidence.

Q. ... Is Cavern City Tours aware of any evidence, whether or not documentary, to show that Hard Rock Café was aware of Cavern City's Cavern Club mark prior to 1996?

A. My answer will be I could only assume that Hard Rock did have knowledge. I've got no documentary or anecdotal evidence that I can remember that they did. It's a long time ago.

Jones I at 84. And more specifically, regarding the Toronto radio interview:

Q. Do you have any evidence that Hard Rock Café was aware of that interview in 1994?

A. I don't have any evidence of that, no.

Id. Thus, there is no evidence of petitioner expressing an interest in opening a Cavern Club in the United States other than the Toronto interview, and no evidence that anyone associated with respondent even heard the interview.

Petitioner would have us charge respondent with knowledge of petitioner, petitioner's advertising and petitioner's plans for expansion into the United States essentially because of respondent's status as an international corporation, its focus on rock and roll, its possession of rock and roll memorabilia including Liverpool Cavern Club bricks and the fact that Mr. Jones announced petitioner's plans for expanding into the United States on a

radio station.³ The Federal Circuit has made clear that fraud must be proven to the hilt and that the "should have known" standard for attributing knowledge is not the proper one. *In re Bose Corp.*, 91 USPQ2d 1938, 1939 - 40 (Fed. Cir. 2009) (By equating "should have known" of the falsity with a subjective intent, the Board erroneously lowered the fraud standard to a simple negligence standard."). Rather, "[t]he principle that the standard for finding intent to deceive is stricter than the standard for negligence or gross negligence ..." *Id.* at 1941. Also, on the element of intent, while subjective intent to deceive is an indispensable element in the analysis and difficult to prove, "inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement." *Id.*, citing *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 88 USPQ2d 1001 (Fed. Cir. 2008).

Additionally, in *M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d 1544, 1550 - 51 (TTAB 2010), decided by the Board after the Federal Circuit handed down *Bose*, the Board indicated that in considering indirect evidence such as the evidence we have in this case, no reasonable conclusion other than the intent to deceive should be reached:

³ Petitioner also cites respondent's "deep involvement with trademarks" but does not explain what it means by "deep involvement with trademarks" and petitioner has not offered any evidence that respondent has a "deep involvement with trademarks."

Under the circumstances of this case, finding particularly that MCI sought advice of counsel, we cannot conclude that MCI intended to deceive the USPTO. That is, we will not draw an inference that MCI acted with the intent to deceive the Trademark Office without some factual basis for drawing such an inference. In this case, it was incumbent upon Bunte to establish such a factual basis by, for example, eliciting further testimony as to the actual advice MCI received when it "discussed with counsel" the list of goods it intended to include in the application and whether or to what extent MCI relied on such advice. We will not infer, against MCI, that counsel necessarily advised MCI that it was not entitled to seek registration of the mark for goods upon which the mark was not in use, and that MCI ignored that advice. Because fraud must be proven "to the hilt" with clear and convincing evidence, and any doubt must be resolved against the charging party, *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ at 1044, Bunte failed to show, by direct evidence, that MCI intended to deceive the USPTO or, by indirect evidence, that the Board could draw no reasonable conclusion other than that MCI intended to deceive the USPTO.

The inferences petitioner would have us draw are far too tenuous to establish that respondent knew of any claimed rights to THE CAVERN CLUB mark in the United States and intended to deceive the Office when representing in its application that it knew of no other person having the right to the mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the services of such other person, to cause confusion, or to cause mistake, or to deceive. We therefore find that respondent has not met its "heavy burden of proof" in showing fraud. *W.D. Byron &*

Sons, Inc. v. Stein Bros, Mfg. Co., 377 F.2d 1001, 153 USPQ 749 (CCPA 1967). Respondent's claim of fraud is dismissed.

False Suggestion of a Connection

Section 2(a) prohibits registration of "matter which may ... falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols" In *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 508-509 (Fed. Cir. 1983), the Federal Circuit explained that Section 2(a) was designed to protect "the name of an individual or institution which was not a technical 'trademark' or 'trade name' upon which an objection could be made under Section 2(d)"; and that Section 2(a) embraces the concepts of the right to privacy and the related right of publicity.

The Board requires that a plaintiff asserting a claim that a mark falsely suggests a connection with persons, living or dead, or institutions, demonstrate:

- (i) that the defendant's mark is the same as, or a close approximation of, plaintiff's previously used name or identity;
- (ii) that the defendant's mark would be recognized as such by purchasers in that the mark points uniquely and unmistakably to petitioner;
- (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and
- (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed.

See *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956 (TTAB 2007); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

We initially address petitioner's comments on what it must establish depending on whether petitioner is considered an "institution" under Section 2(a) entitled to rely on the "historic fame" of The Cavern Club, i.e., any fame of the original Cavern Club where the Beatles regularly performed in the 1960s, or a "juristic person." Petitioner states at p. 6 of its reply brief:

If the Cavern Club is considered an "institution", historic fame is simply not a separate issue because that question is subsumed in the determination of whether the Cavern Club is an institution. And if the Cavern Club is considered a "juristic person," the relevant inquiry is whether HRC's use unmistakably points back to the Cavern Club's perceived persona or personality, to which the Cavern Club's history is inextricably attached.

Reply at 6.⁴ It does not matter whether The Cavern Club is considered an "institution" or a "juristic person"; in order to prevail, petitioner must demonstrate that petitioner's persona or identity is THE CAVERN CLUB, not whether THE CAVERN CLUB is the persona or personality of The Cavern

⁴ At p. 18 of its reply, petitioner states that "as a juristic person, Petitioner can sustain a § 2(a) false suggestion claim because it can show that HRC's use of the mark CAVERN CLUB points unmistakably back to the Cavern Club's/CCT's identity, persona or personality." Reply at 18.

Club.⁵ Petitioner has pleaded that CAVERN CLUB is identical to petitioner's mark THE CAVERN CLUB and such use is intended to falsely suggest a connection with petitioner. Complaint ¶ 21. Further, it has pleaded that respondent's use points uniquely and unmistakably to petitioner. The first factor listed above requires that the defendant's mark be the same as, or a close approximation of plaintiff's previously used name or identity. Because petitioner's name is not The Cavern Club, it must establish that its identity or persona is The Cavern Club. For the three reasons discussed below, petitioner has not persuaded us that THE CAVERN CLUB is petitioner's persona or identity.

First, the record has little, if any, evidence tending to demonstrate that THE CAVERN CLUB is the identity or persona of petitioner. While petitioner introduced into the record numerous articles from United States publications discussing or mentioning The Cavern Club, all but a handful of those articles mention Cavern City Tours Ltd.'s name. Those that do mention petitioner are not helpful to petitioner.⁶ Exhibit E to Mr. Jones trial deposition, a

⁵ Also, we need not determine whether petitioner is a "person" or an "institution" because its claim fails either way.

⁶ At p. 98 - 101 of petitioner's Federal Rule 30(b)(6) deposition (Jones I), Mr. Jones states that petitioner relies on information on websites (without specifying which ones), interviews, newspaper articles, brochures, travel articles and travel guides to establish an understanding in the United States that Cavern City is affiliated with Cavern Club. The brochure he pointed to, however, was dated 1987, before petitioner began operating The Cavern Club (in 1991), had "Cavern City Tours" on the front and

copy of December 1996/January 1997 issue of *Britain Calling*, published by the British Tourist Authority and distributed in the United States, is an example. It states:

BEATLES' CAVERN CLUB IS 40

1997 marks the 40th anniversary of the Cavern Club in Liverpool, the night-spot where The Beatles and many other pop musicians started on the road to fame. Today's Cavern Club stands on the site of the original in Mathew Street and plans celebrations throughout the year. ...

Liverpool, 210 miles north-west of London, has much to see from the Beatles and Merseybeat era, and there is a daily "Magical Mystery Tour" to sites including Penny Lane and Strawberry Fields. Tickets, £7.95, tel. 0151-236 8081.

Press contact: Dave Jones, Cavern City Tours Ltd., 10 Mathew Street, Liverpool

No association is made between The Cavern Club and Cavern City Tours Ltd. Moreover, the reference to *Magical Mystery Tour*, appearing proximate to *Cavern City Tours*, further distances any association between The Cavern Club and Cavern City Tours Ltd.

We also find Mr. Jones's testimony in this regard unpersuasive because it is self-serving and based on conjecture:

Q. Now, you don't believe that Americans, to the extent that they are aware of The Cavern Club, are

stated "included on our *Magical Mystery Tour* ... attractions such as Big Ben, Buckingham Palace, Roy Orbison, the Beatles' homes, Abbey Road, The Cavern." Jones I at 102. This type of evidence does not establish that the persona of Cavern City Tours Ltd. is The Cavern Club. Also, the articles dated prior to 1991 have no probative value.

aware of Cavern City Tours being affiliated with it, do you, for the most part?

A. I believe that there's a significant number of Americans who directly associate Cavern City Tours with The Cavern Club. Yes, I do.

Q. Are those people that have been to The Cavern Club, or do you include people that have not been to the Cavern Club once it was taken over by Cavern City?

A. I would think that there is a significant number of Americans who have not visited Liverpool who know full well that Cavern City Tours are associated with The Cavern Club.

Q. Do you have any evidence to support that belief besides your presumption?

A. Only anecdotal.

Q. What kind of anecdotal evidence do you have?

A. From visitors saying, "So-and-So told me that I might have to come here and visit The Cavern Club."

A. Anything else?

Q. Not really.

Jones I at 70 - 71. Thus, little, if any, of petitioner's evidence establishes that The Cavern Club is petitioner's identity.⁷

⁷ Petitioner must establish that The Cavern Club is petitioner's identity or persona; simply owning a famous mark is insufficient. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1663-64 (TTAB 2002) ("Opposer has not presented evidence sufficient to establish ... that applicant's ROADRUNNER MAPS and design mark is the same as or a close approximation of opposer's name or identity. ... Opposer owns ROAD RUNNER trademarks, but neither applicant's ROADRUNNER MAPS and design mark, nor even opposer's ROAD RUNNER mark or cartoon character, constitutes opposer's name or identity."); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1224 fn.5 (TTAB 1987) ("To prevail on a Section 2(a) counterclaim of a false suggestion of a connection, a party must

Second, much of the evidence in the record concerns the significance of the original Cavern Club to Beatles fans and makes no mention of petitioner. In discussing The Cavern Club of the Beatles era, the evidence links The Cavern Club to the original proprietors of The Cavern Club, not to petitioner. THE CAVERN CLUB, which petitioner asserts is its identity or persona, must point uniquely to petitioner. See *Calvin Klein Industries Inc. v. Calvins Pharmaceuticals Inc.*, 8 USPQ2d 1269, 1272 (TTAB 1988) ("The record clearly establishes that a third party -- Calvin Clothing Corporation -- has made use of CALVIN, a term virtually identical to CALVINS. Indeed, the use of CALVIN on apparel by Calvin Clothing Corporation predates any use of CALVIN or CALVIN KLEIN by opposer. Opposer had the burden of establishing that CALVINS points uniquely to opposer."). By also pointing to the original Cavern Club, the evidence does not point uniquely to petitioner.

Further, the record as a whole reflects that petitioner's customers from the United States visit The Cavern Club not because of any attractions or performances at The Cavern Club, but because they want to visit a place where the Beatles gave musical performances in the 1960s. See Mr. Gehr's expert testimony at 9:

prove a unique and unmistakable reference to itself as a persona, and not merely the use of confusingly similar names.").

Q. Do you think ... a new Cavern Club[,] if there was never an old Cavern Club[,] would be known in the United States?

A. No.

See also Mr. Thompson's expert testimony at p. 9:

Q. In your opinion, would the Cavern Club be as internationally famous as it is if it were not open to this day?

A. I think it would - if it were not open - even if the Cavern Club had ceased to exist totally, it would still remain widely known amongst Beatles fans. As you know, the Beatles remain large in western culture, not just British culture but also American culture in western culture, and that great story of the origin of the Beatles there, the days when they were young and full of energy, that is intimately linked with the Cavern Club. This is where they became the Beatles."

Similarly, Mr. DeCurtis testified at pp. 11 - 12 of his trial deposition:

Q. If there was never an old Cavern Club, regardless of whether the Beatles played somewhere in Liverpool, do you believe that the current version of the Cavern Club would be known or famous?

A. Not if the Beatles had never played at the Cavern Club.

And, at p. 18, Mr. DeCurtis testified:

Q. But would these people that know of the Cavern Club relate it to the birthplace of the Beatles, or would they relate it separately to the new Cavern Club that was built after the first one was demolished?

A. I think they would relate it to the birthplace of the Beatles.⁸

⁸ Because of their curiosity about the location where the members of the Beatles performed early in their careers, we cannot

Also, Mr. Jones testified:

Q. Besides the history of the old Cavern Club, do you believe the new Cavern Club that opened in 1984 was famous in its own right in any way?

A. No, only in the fact that it was the continuing history of The Cavern since 1957.

Q. And would that same answer be true for The Cavern City Cavern Club when it opened in 1991?

A. Yes.

Jones I at 69 - 70. In sum, it does no dishonor to the hallowed space at 10 Mathew Street in Liverpool to conclude that the evidence of record fails to establish that THE CAVERN CLUB points uniquely to petitioner.

Third, petitioner, which maintains that THE CAVERN CLUB is its persona, is a company with more than one business interest and trademark. In addition to running The Cavern Club as an entertainment venue, petitioner operates Magical Mystery Tour in Liverpool, a tour operator which takes tourists to Beatles related sites, not limited to The Cavern Club. Other evidence establishes that petitioner has won awards in several consecutive years - not as an entertainment venue but as a tour operator. Jones 103 - 104; Jones test. Ex. N. We find petitioner's offering of services other than live musical performances and especially conducting tours, which are different in nature from live

exclude the possibility that fans of the Beatles would visit The Cavern Club even if it were, e.g., a haberdashery.

musical performances, inconsistent with petitioner's position that its persona is The Cavern Club. That petitioner offers another service under a different mark undercuts its argument that petitioner's persona is The Cavern Club.

It also has not escaped our attention that petitioner relies on its control (by means of a lease which expires in 2028) of the premises at 10 Mathew Street in asserting its false suggestion claim. It is asserting control over the same premises and conducting the same business as no fewer than four previous entities. Under petitioner's reasoning, each one of these entities would have had the same identity as that asserted by petitioner in its brief, The Cavern Club. Petitioner has not pointed to any persuasive evidence that suggests that it has the persona of The Cavern Club as opposed to any of the other earlier Cavern Clubs. We find it implausible that any entity that operates The Cavern Club as a musical entertainment establishment under The Cavern Club name in the same location automatically has The Cavern Club as its identity.

In summary, we find that petitioner has not established that its name is unmistakably associated with a particular personality or "persona" that points uniquely to the plaintiff. *Notre Dame du Lac*, 217 USPQ at 508.

Cancellation No. 92044795

Accordingly, petitioner's false association claim is also dismissed.

DECISION: The petition to cancel is dismissed on the asserted grounds of fraud and false suggestion of a connection.